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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,335	09/08/2003	Seth Haberman	0813808.13102	1662

22832 7590 06/30/2011

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EXAMINER	
LANGHNOJA, KUNAL N	

ART UNIT	PAPER NUMBER
2427	

NOTIFICATION DATE	DELIVERY MODE
06/30/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/657,335	HABERMAN ET AL.	
	Examiner	Art Unit	
	KUNAL LANGHNOJA	2427	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 April 2011*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/25/2011 have been fully considered but they are not persuasive.

With respect to claim 1, applicant argues cited references fail to teach claimed limitation “assembly information.” The examiner respectfully disagrees.

Hite et al teaches a system and method of delivering targeted advertisements to consumers. The reference teaches at the point of usage, a commercial processor is programmed to find and analyze the CID codes in commercial. When a match is found between transmitted and stored CID codes, the commercial is presented at a single preemptable position in a specific program. Furthermore, a sequence code is stored at the point of display, which would be used to compute a new CID code for subsequent commercials. Thus, commercials including a story line, which plays out in determined sequence. In addition, the reference teaches commercial spots when addressable ads will have a unique identifier code. These codes are transmitted by the network or locally in local avails spots. The program delivery system will broadcast a default commercials in the spot eligible for the addressable ads. Furthermore, commercial processor will find and analyze CID code in each commercials and would apply display rules and substitute default commercials (Col.4 lines 3-11, lines 45-51 and Col.7 lines 15-34).

In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., contemporaneously with displaying the message) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no teaching, suggestion, or motivation to combine the references, the examiner recognizes that obviousness may be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), and *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007). In this case, Hite et al teaches a system and method of delivering targeted advertisements to consumers. Furthermore, a sequence code is stored at the point of display, which would be used to compute a new CID code for subsequent commercials. Thus, commercials including a story line, which plays out in determined sequence. Hite et al is unclear with respect to each media segment is not a complete individual advertisements. In similar field of endeavor, Byers et al teaches each media segment is not a complete individual advertisements (i.e. altering elements within stream to fit user profile) (Col.1 lines 50-52, Col.2 lines 41-67 and Col.10 lines 1-9). In addition, the reference discloses utilization of invention including, but not limited to, target products placement, target advertising, etc. Thus, it would have been obvious to one of ordinary skill in the art to modify system and method for delivering targeted advertisements to consumers of Hite by specifically

adding each media segment is not a complete individual advertisements, as taught by Byers for the common knowledge purpose of dynamically alerting video images to allow customization of digital stream based upon characteristics associated with a user (Col.1 lines 40-44 and lines 50-59).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant assumption of the combination of Hite and Byers would not only yield a system in which entire commercials were transmitted to a viewer and that commercial has a spatial portion of the video image (Pepsi can) spatially altered with another image (Coca-Cola can) either at service node or in a subscriber terminal (Col.8 lines 54-59), but also yield a sequence code being stored at the point of display, which would be used to compute a new CID code for subsequent commercials. Thus, commercials including a story line, which plays out in determined sequence presenting a commercial break (claimed: message campaign), as taught by Hite.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-13 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al (United States Patent 5,774,170), in view of Byers et al (United States Patent 7,334,249).

Regarding claim 1, Hite teaches "a method for creating a message campaign, said message campaign allowing the creation of a plurality of different individual advertisements for targeted audiences, based upon criteria of said targeted audiences,"(Figure 1; Abstract, Col.4 lines 3-11, Col.10 lines 54-67) comprising:

"providing a matrix-based narrative (i.e. commercials including a story line, which plays out in determined sequence) comprising a plurality of media slots arranged at specific time points within said message campaign (i.e. commercial break includes multiple commercials, wherein the default commercials are replaced by sequenced targeted commercials) (Col.4 lines 3-11, lines 45-51 and Col.7 lines 15-34);"

"providing a plurality of media segments (i.e. multiple commercials), said media segments configured to be assembled into said plurality of media slots, wherein at least one of said media segments is interchangeable with another one of said media segments. (i.e. based on CID codes, different commercials is/are displayed at different sites)" (Figure 1; Col.4 lines 3-11);

"providing assembly information (i.e. CID code) regarding how said plurality of media segments (i.e. commercials) may be assembled to create said plurality of individual advertisements (i.e. targeted commercials);" (Col.4 lines 3-11, Col.5 lines 40-50) and

"associating said assembly information (i.e. CID codes) with said plurality of media segments (i.e. commercials);"(Col.5 lines 58-62) However, the reference is unclear with respect to wherein each media segment is not a complete individual advertisement."

In similar field of endeavor, Byers et al teaches wherein each media segment is not a complete individual advertisement (i.e. changing elements within stream to fit user profile). (Figure 6; Col.2 lines 41-67 and Col.10 lines 1-9). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the reference for the common knowledge purpose of dynamically alerting video images to allow customization of a digital stream based upon characteristics associated with a user (Col.1 lines 40-44).

Regarding claim 2, Hite et al teaches "an individual advertisement for a specific targeted audience is assembled at a later time (i.e. targeted commercial is displayed based on the CID code saved at the receiver), said individual advertisement message being assembled based upon said assembly information (i.e. each commercial includes CID code), said plurality of media segments, and on information regarding said target audience. (Hite: Col.4 lines 3-11, Col.5 lines 40-50, 58-62 and Col.10 lines 54-67 and Byers: Figure 6; Col.2 lines 41-67 and Col.10 lines 1-9)

Claim 3 is rejected wherein “at least one media segment used to assemble one of said individual advertisements is created at said later time.” (Col.5 lines 40-50, 58-62 and Col.6 lines 10-13)

Claim 4 is rejected wherein “assembly information(i.e. CID codes) includes rules for use at said later time, said rules for use in determining which of said plurality of said media segments (i.e. commercial) to use in assembling an individual advertisement (i.e. targeted commercial) for said specific targeted audience, based on said information regarding said target audience.” (Col.4 lines 3-11, Col.5 lines 40-50, 58-62, Col.6 lines 10-13, Col.10 lines 54-67)

Claim 5 is rejected wherein “rules include default conditions for determining which of said plurality of said media segments to use when no appropriate information regarding said target audience is available.”(Col.4 lines 12-18, Col.6 lines 3-6)

Claim 6 is rejected wherein “media segments include audio, video, voice overs, and background music.”(Col.10 lines 11-16)

Claim 7 is rejected wherein “a subset of said plurality of media segments form a default generic individual advertisement.” (Col.4 lines 12-18, Col.6 lines 3-6)

Claim 8 is rejected wherein “said assembly information includes data representing time segments; said media segments, and conditions.”(Col.4 lines 3-18 and Col.5 lines 58-62)

Claim 9 is rejected wherein “said individual advertisement for a specific targeted audience is assembled in a set top box for a television receiver contemporaneously with

displaying said individual advertisement to said specific targeted audience (i.e. a sequence of commercial are generated)." (Col.4 lines 45-51 and Col.5 lines 40-50)

Claim 10 is rejected wherein "the plurality of media segments includes alternative segments of different lengths."(Col.5 lines 58-62)

Claim 11 is rejected wherein "the assembly information contains a role for choosing each of the media segments." (Col.4 lines 34-40)

Claim 12 is rejected wherein "the rule for choosing a media segment depends on the outcome of a previous choice." (Col.4 lines 52-61)

Claim 13 is rejected wherein "the assembly information contains a rule disallowing a combination of media segments."(Col.4 lines 34-44)

Claim 19 is rejected wherein "the media segments include video segments and other media segments."(Col.5 lines 40-50)

Claim 20 is rejected wherein "the other media segments include audio segments." (Col.5 lines 40-50)

Claim 21 is rejected wherein "the assembly information includes roles for the assembly of the video segments and rules for the assembly of the other media segments." (Col.4 lines 3-11, lines 45-51, Col.5 lines 40-62)

4. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hite et al, in view of Byers et al, further in view of Khusheim et al (United States Patent Application Publication 2003/0221191).

Regarding claim 14, Hite and Byers, the combination teaches everything claimed (see claim 1). However, the combination is unclear with respect to "each media segment is associated with a segment parameter, the assembly data including a rule basing a choice of a media segment on its associate segment parameter."

In similar field of endeavor, Khusheim teaches " each media segment (i.e. commercial) is associated with a segment parameter (i.e. criteria), the assembly data including a rule basing a choice of a media segment (i.e. commercial) on its associate segment parameter (i.e. criteria)."(Paragraphs 0040, 0042, 0046, 0104) Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination for the common knowledge purpose of providing target commercials based on user's criteria.

Regarding claim 15, Hite, Byers and Khusheim, the combination teaches everything claimed (see claim 15). The combination teaches "the segment parameters identify a demographic of an intended audience."(Khusheim: Paragraph 0011, 0046)

Regarding claim 16, Hite, Byers and Khusheim, the combination teaches everything claimed (see claim 15). The combination teaches "the segment parameters identify an environmental condition."(Khusheim: Paragraphs 0045 and 0046)

Regarding claim 17, Hite, Byers and Khusheim, the combination teaches everything claimed (see claim 15). The combination teaches "a media segment is

associated with a plurality of different segment parameters."(Khusheim: Paragraph 0011, and 0046)

Regarding claim 18, Hite, Byers and Khusheim, the combination teaches everything claimed (see claim 17). The combination teaches is rejected wherein "the different segment parameters are assigned priorities, the assembly data including a role basing a choice of a media segment on the different segment parameters according to the assigned priorities."(Khusheim: Paragraphs 0011, 0045 and 0046)

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUNAL LANGHNOJA whose telephone number is

(571)270-3583. The examiner can normally be reached on M-F 10:00 A.M.- 6:30 P.M. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on 571-272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. L./
Examiner, Art Unit 2427

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427